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Dated: April 27, 2006

Signature: _____

(Randall G. Rueth)

Docket No.: 29488/39975
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark A. Wagner et al.

Application No.: 10/772,804

Confirmation No.: 5215

Filed: February 5, 2004

Art Unit: 3634

For: STORE LEAD-IN FIXTURE FOR PRODUCT
DUMP TABLE

Examiner: Lindsay M. Maguire

SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. The Standard for Requiring Restriction Has Not Been Met

The restriction requirement is improper on its face because it does not meet the minimum required standard set forth in MPEP §803. Section 803 requires two criteria for a proper requirement of restriction for purported patentably distinct inventions. First, the inventions must be independent (*see* MPEP 802.01, 806.04, 808.01) or distinct (*see* MPEP 806.05 – 806.05(i)) as claimed. Second, regardless of whether the inventions are independent or distinct, there "must be a **serious burden** on the examiner if restriction is required." (emphasis added) (*see* MPEP 803.02, 806.04(a) - 806.04(i), 808.01(a), and 808.02) Referring to the second requirement, §803 recites that "if the search or examination of an entire application can be made *without serious burden*, the examiner *must examine it on the merits*, even though it includes claims to independent or distinct inventions." (emphasis added)

There is no evidence in the record that search and examination of the entire application would be any burden, much less a serious burden, on the examiner, as is necessary for upholding a proper restriction requirement. There is absolutely no burden on the examiner to search for the groups divided in the Restriction Requirement, because all

three groups need to be searched simply to properly examine the independent claims. Furthermore, all three of the groups are assigned to the exact same class (211) and to subclasses having only slight differences¹. Because the search and examination of the entire application can be made without serious burden on the examiner, it is wasteful of time, effort, and resources for both the Applicants and the Patent Office to prosecute the claims in separate applications. Search and examination of all claims together in this application would be much more efficient than requiring both the Patent Office and the Applicants to do so separately in multiple applications.

The Applicants further submit that contrary to the requirements of MPEP 803, the Restriction Requirement has not provided sufficient reasons or examples for concluding that patentably distinct inventions exist within the application. In particular, the Restriction Requirement has not defined the identified groups according to mutually exclusive characteristics. MPEP 806.05(d), has two requirements for proving distinctness between related products: (1) "the subcombinations do not overlap in scope" and (2) the subcombinations "are not obvious variants."

In this case, however, the Restriction Requirement has not established that the identified products do not overlap in scope (i.e., recite mutually exclusive characteristics) under the standard recited above. In particular, independent claim 1 (identified Group I), independent claim 11 (identified Group II), and independent claim 16 (identified Group III) recite, *inter alia*, a store lead-in fixture for a product dump table having a side wall terminating in a top edge adjacent a product receiving cavity, where the store lead-in fixture includes a support structure to be placed in confronting relation to the side wall of the product dump table; a mounting structure to be placed in operative association with the top edge of the product dump table; and a presentation structure for visually displaying product on the side wall of the product dump table. As a result, the identified groups overlap in scope and

¹ Applicants respectfully submit that all three sets of claims should be classified in the same subclass. Claims in Group I have been assigned to subclass 90.02 for support racks with an adjustable shelf, and claims in Group II have been assigned to subclass 90.01 for support racks with a shelf. However, independent claims 1 and 11 do not include any recitations directed to the adjustability of a shelf. Thus, both claims 1 and 11 would cover a store lead in fixture having a fixed shelf as well as a store lead in fixture having an adjustable shelf. Additionally, claims in Group III have been assigned to subclass 86.01 for specially mounted support racks. However, claim 16 does not include any recitations directed to a special mounting of the store lead in fixture to the power aisle dump table.

the above-mentioned characteristics are not mutually exclusive. The Examiner has therefore improperly identified each of these features as relating to a separate invention (i.e., identified species groups I, II and III).

Arguments presented on page 2 of the Restriction Requirement allege that the “subcombination II has separate utility such as a product receiving cavity.” However, not only is this feature recited only in the preamble of claim 11 (identified Group II), it is also recited in the preamble of claim 1 (identified Group I). Thus, the claims identified in Group II do not have separate utility from the claims identified Group I.

Additional arguments presented on page 2 of the Restriction Requirement allege that the “subcombination III has separate utility such as a product hanging projection and an end panel” from subcombination I. However, the product hanging projection and end panel recited in claim 16 are merely additional features recited in the claim in combination with the generic recitations recited above that overlap between the two sets of claims. Namely, claims 1-10 and claims 16-20 have in common:

a store lead-in fixture for a product dump table having a side wall terminating in a top edge adjacent a product receiving cavity, where the store lead-in fixture includes a support structure to be placed in confronting relation to the side wall of the product dump table; a mounting structure to be placed in operative association with the top edge of the product dump table; and a presentation structure for visually displaying product on the side wall of the product dump table.

Applicants respectfully submit that the additional features recited in claim 16 simply provide a claim that is more detailed than claim 1 and varied in scope, yet not to the point that a restriction requirement is appropriate. Adding claims that vary in scope has been the standard practice for centuries. In fact, the MPEP expressly states at 608.01(m) that:

Many of the difficulties encountered in prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive.

This is exactly what the Applicants have done in the present application. Applicants respectfully submit that the Restriction Requirement is inappropriate as the Applicants have merely submitted claims varying in scope. For at least this reason, the Restriction Requirement should be withdrawn.

Additional arguments presented on page 3 of the Restriction Requirement allege that the "subcombination III has separate utility such as a product hanging projection and an end panel" from subcombination II. However, similar to the arguments presented immediately above, the product hanging projection and end panel recited in claim 16 are merely additional features recited in the claim, in combination with the generic recitations recited above that overlap between the two sets of claims. Thus, this restriction should also be withdrawn.

The Applicants therefore traverse the restriction requirements on the grounds that the minimum standard for a restriction requirement as set forth in MPEP §803 has not been met. The restriction requirements should be withdrawn and all of claims 1-20 searched and examined in the present application. Such action is hereby respectfully solicited.

II. Effect of Improperly Upholding the New Restriction Requirement

The effect of the Patent Office upholding the improper restriction requirement is that the Patent Office admits that the claims of, for example, Group I are patentably distinct over the claims of Groups II and III. MPEP §802.01 states that distinctness for a restriction requirement means that two or more subjects as claimed "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." (emphasis in original) The effect of upholding the restriction requirement is that the Patent Office admits that the claims of the elected group are patentable over any disclosure of the claims of the non-elected groups, and vice versa.

The patentability position is required for entry of the restriction requirement by the Patent Office. Thus, if the restriction requirement is upheld, the applicants can and will rely upon this position during examination of this application and any continuing or divisional applications. If this position is not to be taken by the Patent Office, then the applicants request that the restriction requirement be withdrawn.

III. Provisional Election

The Applicants *provisionally elect*, as required for a complete response, claims associated with the embodiment alleged to be Group I (claims 1-10) and alleged species of Figures 1-2 (claims 1-10), in the Restriction Requirement. The Applicants make this provisional election *with traverse* in accordance with the foregoing remarks.

CONCLUSION

Reconsideration and withdrawal of the restriction requirement is solicited for the foregoing reasons. As a result, consideration and examination of all of claims 1-20 pending in the application is further solicited. No fees are believed to be due. However, if there are any additional fees or refunds required, the Commissioner is directed to charge or credit Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

Should the examiner wish to discuss the foregoing or any matter of form in an effort to advance this application toward allowance, the examiner is invited to telephone the undersigned at the below-listed number.

Dated: April 27, 2006

Respectfully submitted,

By 

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